



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,052	06/20/2003	Aaron Kelly	31132.129	6026

46333 7590 07/19/2006

HAYNES AND BOONE, LLP  
901 MAIN ST  
SUITE 3100  
DALLAS, TX 75202

EXAMINER
----------

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
----------	--------------

3733

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/600,052

Applicant(s)

KELLY ET AL.

Examiner

Pedro Philogene

Art Unit

3733

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,26-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 101-103, 106-110, 112-113 of copending Application No. 09/924,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1-20 of the application and claims 101-103, 106-110, 112-113 of the copending application lies in the fact that the copending application claims include many more elements and are thus more specific. Thus, the invention of claims 101-103, 106-110, 112-113 of the copending application is in effect a "species" of the "generic" invention of claims 1-20. It has been held that the generic invention is "anticipated" by the "species"

Art Unit: 3733

See in re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-20 of the application are anticipated by claims 101-103,106-110,112-113 of the copending application, they are not patentably distinct from claims 101-103,106-110,112-113.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,8, 9, 17, 18,19,26-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Viart et al. (FR 2,805,985).

With respect to claims 1, 26, 34, Viart et al disclose a body member (1) for use with a shell (2,3) to form an implantable endoprosthesis, the body member comprising a first component (5) formed from a wear resistant first material, and a second component (4) formed from a resilient second material, wherein the body member is adapted to articulate with the shell (2,3) such that one or more surface of the shell come into contact with the first component, as best seen in FIGS.1-3, a third portion positioned at least partially between the

Art Unit: 3733

first and second portions, the third portion formed from a resilient material; as best seen in FIG.2.

With respect to claims 2, 17, Viart et al disclose a second central component (4) disposed between the first component and a third component (5) also formed from the first material, as best seen in FIG.2.

With respect to claims 8, 9, Viart et al disclose first material comprising a wear resistant polymer and the polymer comprises polyethylene; as set forth in page 3, lines 28.

With respect to claims 18,19, Viart et al disclose a device wherein the third and the first components includes portions including lips protrusion and a flexible engaging member; as best seen in FIGS, 1-3.

Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al (6,146,421).

With respect to claim 20, Gordon et al disclose a body member for use with a shell structure of an implantable endoprosthesis comprising wear resistant material selected from the group consisting of cobalt chrome alloy; as set forth in column 3, lines 1-7, wherein the body member is adapted to articulate with respect to one or more surfaces of the shell structure of the endoprosthesis; as best seen in FIGS.4-7.

***Claim Rejections - 35 USC § 103***

Art Unit: 3733

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7,10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viart et al (FR 2,805,985).

With respect to claims 3-7, 10-16, it is noted that Viart et al teach all the limitation except for the material being one or more metal and the metal is an alloy and the alloy is cobalt-chrome alloy, and the material is ceramic herein the ceramic is alumina or zirconia and a molecular weight ranging from about  $5.0 \times 10^5$  grams/mol to about  $6.0 \times 10^6$  grams/mol; polyethylene having modulus of elasticity ranging from about 0.7 to about 3.0 Gpa; A polyethylene cross-linked to an extent ranging between about 0 to about 50% as measure by a swell ratio; polymer comprising (PEEK) and the second material comprises polymer having durometer ranging from about 75A to about 65D; as claimed by applicant.

However, it would have been obvious to one having ordinary skill in the art to use any known or preferred material; since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. As to the ranges and percentages as claimed by applicant. It would have been obvious to one having ordinary skill in the art to reach an optimum range, since it has been held that where the general conditions of a claim are

Art Unit: 3733

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Response to Amendment***

Applicant's arguments filed 5/15/06 have been fully considered but they are not persuasive. Applicant's argument about the restriction and double patenting rejection is not persuasive. The restriction is proper for the simple reason that the double patenting rejection is proper. For the double patenting rejection the applicant's attention is directed towards the claims in the 09/924,298 application. In those claims applicant only claiming the body member. Although the shell structure is in the claims, it is not being positively claimed. Therefore, the restriction and the double patenting are proper.

Applicant's arguments, see Remarks, filed 5/15/06, with respect to the rejection(s) of claim(s) 1-4,6-9,17-20 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Viart et al. (FR 2,805,985).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,682,562                      1-2004                      Viart et al  
(FR 2, 805,985 translation).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

Art Unit: 3733

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
July 12, 2006



PEDRO PHILOGENE  
PRIMARY EXAMINER